

REMARKS

Applicant has carefully studied the Office Action of March 24, 2004 and offers the following remarks in response to accompany the above amendments.

Claims 5, 8, 12, 17, 20, and 24 were objected to for reciting "the group," which the Patent Office alleges has insufficient antecedent basis. Applicant respectfully traverses. Claims 5, 8, 12, 17, 20, and 24 contain Markush groups, which are well understood by the Patent Office. By their very nature Markush groups necessitate recitation of language stated "from the group." See MPEP § 2173.05(h). As such, the term "the group" does not require antecedent basis, and this objection is not well founded. While Markush claims are not common, their use in this instance does not merit an objection, and Applicant requests withdrawal of the objection at this time.

The Patent Office next objected to the drawings for failing to disclose a "characteristic" recited in claim 1. Applicant respectfully traverses. The term characteristic is defined on page 4, in paragraph 10 to include "relative volume for conveying the message, a type of personality, nationality, or ethnicity; and an emotion to associate with the meaning of the message." Figure 2 clearly illustrates all three characteristics, and thus, characteristics are present in the drawings as required by 37 C.F.R. § 1.83(a). As further explained in paragraph 34, the characteristics are stored in a profile, and the specification herein references Figure 2. Thus, Figure 2 shows not only the profile, but also the characteristics recited in the claim and as defined by the specification. While Applicant understands that it is sometimes possible to overlook things stated in the specification, the clear recitation in paragraphs 10 and 34, as well as the corresponding images in Figure 2, preclude an allegation that the drawings do not show a feature specified in the claims. Applicant requests withdrawal of the objection to the drawings at this time.

Claims 1, 13, and 25 were rejected under 35 U.S.C. § 112 as being indefinite. Applicant respectfully traverses. The Patent Office alleges that the term "acts" was indefinite because it is unclear what does the "acting," and the Patent Office opined that the "acts" could be performed by the "providing" "a profile," or "at least one characteristic". One of the idiosyncrasies of the English language is that the verbs generally associate with the immediately preceding noun, especially when the verb is preceded by "that." In the present case, the claims recite "at least one characteristic that acts on said message. . . ." One of ordinary skill in the art of the English language would understand this phrase to mean that the characteristic acts on said message. If

requested, Applicant will provide a declaration to this effect, but any other interpretation is a contortion of the English language that is not well supported. In light of this explanation, Applicant requests withdrawal of the § 112 rejection of claims 1, 13, and 25 at this time.

Claims 1, 13, and 25 were further rejected under 35 U.S.C. § 112 as being indefinite for switching between "at least one characteristic" and "message characteristic." While Applicant respectfully opines that one of ordinary skill in the art would interpret the message characteristic to be the at least one characteristic that acts on said message meaning, Applicant herein amends the claim to conform the language to a single term to eliminate any possibility of confusion. In light of the amendment, Applicant requests withdrawal of the § 112 rejection to claims 1, 13, and 25 at this time.

Claim 28 was rejected under 35 U.S.C. § 112 for lack of enablement. Applicant herein cancels claim 28, thereby mooting the rejection thereof.

Before addressing the rejections based on the references, Applicant provides a summary of the present invention so that the remarks are considered in the proper context. The present invention is a system that allows telephony and text based users to communicate over an instant message (IM) program. To facilitate this IM communication, the system provides a translation service for the telephony user that translates voice messages to text and vice versa. To help expand the depth of communication and improve conveyance of nuances or subtleties the telephony user can convey to the text user, the present invention allows the telephony user to define a profile. In the profile, the telephony user links specific characteristics to particular transformations to be imposed upon the message meaning. Thus, a telephony user can utter an intended message by uttering a command, wherein the command has a message meaning and one or more characteristics. The example given in the specification is that the telephony user states "volume 'normal,' personality 'east coast,' emotion 'sadness,' meaning 'hi.'" (see paragraph 35). This entirety of the passage within the "" is a command. This command has three characteristics (volume, personality, emotion) and a message meaning (hi). The audio browser receives these characteristics and acts on the message meaning according to how the profile defines these characteristics. Thus, the text based user receives "Hi. Not doing well right now." :-((see Figure 4).

Applicant herein amends the independent claims to clarify that the command includes the message meaning and the at least one characteristic and the profile interprets the command to

determine how to present the message meaning in the text based instant message. Support for this amendment can be found in paragraphs 35 and 36. No new matter is added.

Claims 1, 2, 4-11, 13, 16-23, 25, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. (hereinafter "Dowens") in view of Taylor. Applicant respectfully traverses. For the Patent Office to establish obviousness in light of a combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the motivation to combine the references with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, the Patent Office must still further show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. If the Patent Office cannot show where each and every claim element is located, the Patent Office has not established *prima facie* obviousness, and Applicant is entitled to a patent.

Dowens discloses a system that provides two-way communication between parties that may have different communication capabilities. Specifically, Dowens contemplates some parties being on voice terminals and some parties being on text terminals. To help effectuate this two-way communication, and particularly a chat function therein, Dowens provides voice to text conversion and vice versa (see abstract of Dowens).

Taylor discloses a dialect recognition program that queries a user with a series of questions so as to identify a dialect with which the user speaks. Based on the identified dialect, the system can then perform voice to text conversion.

Initially, Applicant traverses the combination of the two references. The Patent Office opines that the combination would be obvious to modify Dowens to have the profile as taught by Taylor such that the modified system would be able to support the profile that affects presenting the appearance of the message meaning to the system users. This assertion is a tautology and is not compelling. There is no explanation of what reason exists to change the appearance such that the profile is needed. To this extent, the motivation to combine the references is derived from impermissible hindsight reconstruction using Applicant's disclosure as a template to select isolated components from disparate references. Since there is no motivation to combine the references, the combination is improper and the claims are allowable. Furthermore, there is no evidence that such an arrangement is desirable in the Dowens system. Since such evidence is

required by the Federal Circuit and has not been provided, the combination is improper and the claims are allowable.

Claim 1 recites, "receiving, according to the call dialog, a command derived from an audio command provided by the telephony user, the command including a message meaning and at least one message characteristic." Claims 13 and 25 recite similar elements. The Patent Office, in its analysis of the previously presented language of claim 1 opines that Dowens teaches the audio command at Dowens, col. 1, lines 24-35. As clarified, the claim makes it clear that the audible command includes both the message meaning and the at least one characteristic. In contrast, while the Dowens passage does indicate that the relay device converts voice into a format suitable for a data network terminal, there is no indication of a particular command being given by the voice user, and there certainly is not a command that includes a message meaning and at least one message characteristic as recited in the claim. To this extent, the reference does not teach or suggest the claim element. Applicant has studied Taylor and finds nothing in Taylor that suggests a command with a message meaning and at least one characteristic therein. Taylor is simply a voice recognition program that identifies dialects and simplifies voice to text conversion based on expected pronunciations of particular identified dialects. To this extent the references individually do not teach or suggest the claim element. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the claims are allowable.

Dependent claims 2, 4-11 and 16-23 depend from allowable independent claims and are allowable at least for the same reasons.

Claims 3 and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens in view of Taylor and further in view of Horvitz et al. (hereinafter "Horvitz"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the combination of the references. Applicant notes that the Patent Office has not cured the deficiencies of the base combination of Dowens and Taylor. The combination is improper on this basis, and the claims are allowable. Applicant further notes that the Patent Office has a similar problem with the combination of the three references. Specifically, the Patent Office opines that it would have been obvious to modify Dowens and Taylor to have the profile include a plurality of unique text associated with a plurality of possible message characteristics as taught by Horvitz, so that the combined system of Dowens and Taylor

would be able to support the unique text to the system users. Again, this is a tautology and non-compelling. There is no explanation of why the Dowens/Taylor system needs, or would benefit from, such an arrangement. Nor is there any evidence to support this motivation to combine the references. The combination has been created using Applicant's disclosure and rests on impermissible hindsight. To this extent, the combination is independently improper and the claims are allowable.

Applicant further notes that the addition of Horvitz does not cure the underlying deficiencies of the combination of Dowens and Taylor. Thus, since the Patent Office has not shown a claim element in the references individually, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, Applicant is entitled to a patent.

Claims 12 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens in view of Taylor and further in view of Hodges et al. (hereinafter Hodges). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the combination of the references. Applicant notes that the Patent Office has not cured the deficiencies of the base combination of Dowens and Taylor. The combination is improper on this basis and the claims are allowable. Applicant further notes that the Patent Office has a similar problem with the combination of the three references. Specifically, the Patent Office opines that it would have been obvious to modify Dowens and Taylor to send an alert to the telephony user as taught by Hodges so that the combined system of Dowens and Taylor would be able to support the alert system to the system users. Again, this is a tautology and non-compelling. There is no explanation of why the Dowens/Taylor system needs or would benefit from such an arrangement. Nor is there any evidence to support this motivation to combine the references. The combination has been created using Applicant's disclosure and rests on impermissible hindsight. To this extent the combination is independently improper, and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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Date: June 16, 2004

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